

REMARKS

This Amendment responds to the office action dated June 15, 2005.

The examiner seems to have made an incomplete objection to the abstract. In anticipation of this objection, the applicant has amended to abstract to be more specific.

The examiner has rejected claim 17 under 35 U.S.C. §101 as being directed to non-statutory subject matter. This rejection is improper in that it fails to recognize the useful, concrete and tangible result of the claim. 35 U.S.C. §101 precludes abstract ideas from patentability, however, claim 17, claims the act of “monitoring a print system for a print task failure, saving a failed print task when a print task failure occurs, monitoring said print system for a successful print task, analyzing said successful print task characteristics to determine the capability of the printer to which said successful print task was sent, evaluating said printer’s capability to determine whether said printer can print said failed print task and resending said saved, failed print task to said printer if said printer is capable of printing said failed print task.”, which are useful, concrete and tangible results of the claimed signal. A practical application of an abstract idea is patentable if it produces a useful, concrete and tangible result. *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1601-02 (Fed. Cir 1998). Similar software applications have been held patentable by the Federal Circuit when those applications did no more than manipulate numbers for a useful result. *AT&T Corp. V. Excel Comm. Inc.*, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). In AT&T, the useful result was a modified long-distance telephone bill, in this application; the useful result is a successful, recovered print task. The USPTO has long endorsed this type of claim in

their training guidelines for computer-related inventions. A computer data signal is typically regarded as equivalent to a computer readable medium, which is generally accepted as patentable subject matter when it comprises instructions that cause a computer to create a tangible result. Applicant hereby requests the examiner to reevaluate this rejection.

The examiner has rejected claims 1-10 and 12-17 under 35 U.S.C. §102(e) as being anticipated by Yacoub (U.S. 6452692) (hereinafter Yacoub). The embodiments of the present invention described in these rejected claims and the invention disclosed by Yacoub are very different in function. Regarding claim 1 and claims dependent thereon, Yacoub discloses a method for continuously checking for a print error message (col. 7, lines 55-57), selecting a different printer when an error occurs (col. 8, lines 2-4) and determining the most appropriate printer complying with print job preferences. (Abstract). Yacoub does not disclose a method for monitoring a system for a successful print task and resending a saved, failed print task to a printer to which said successful print task was sent. Yacoub discloses a method for querying the database and re-computing to determine the next available printer (col. 10, lines 2-4) and once the appropriate printer is determined, sending the job to that printer (col. 7, lines 44-46). Yacoub does not monitor subsequent print jobs to determine their success or failure because Yacoub is using an entirely different approach that requires a database. Since Yacoub does not disclose the element of monitoring for a successful print task, claim 1 is allowable in its current form and the applicant respectfully requests that the examiner withdraw this rejection.

Regarding claims 2-10 and 12-17, each of these claims is dependent on claim 1 and is, therefore, patentable for the reasons stated above.

Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over Yacoub in view of Shah (U.S. 6,618,167) (hereinafter Shah). However, this rejection is improper because it fails to present a prima facie case of obviousness.

To establish a prima facie case of obviousness, there must be more than the demonstrated existence of all of the components of the claimed subject matter. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the substitutions required. That knowledge cannot come from the applicants' disclosure of the invention itself.

Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). A proper obviousness rejection includes a recitation of a combination of references that disclose every element of the rejected claim along with a teaching or motivation, in at least one of the references, to combine the references.

The combination of Yacoub and Shah does not disclose the elements of monitoring a print system for successful print tasks and analyzing successful print task characteristics. The examiner cites Yacoub (col. 10, lines 24-26) as disclosing successful print task monitoring. However, this cite reads "then the server 460 would again query

the database and re-compute to determine the next available highest speed printer connected to network 450.” This is a description of the database-oriented system disclosed in Yacoub that does not do successful print task monitoring. This element is not disclosed in Yacoub or Shah.

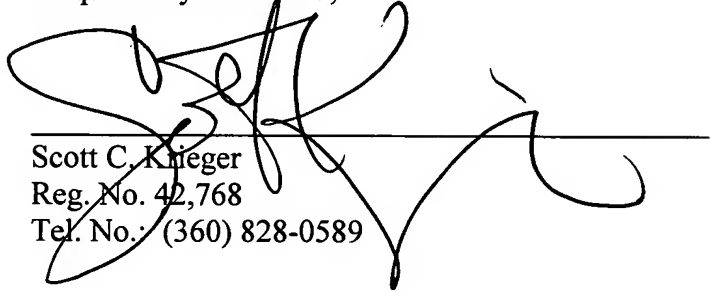
The examiner cites Yacoub (col. 10, lines 21-35) as disclosing analysis of a successful print task. This cite reads “ If however, after submitting the print job by the server, the high-end desktop laser printer 412 was out of paper and returned an error message to server 460 informing it that it is out of paper, then the server 460 would again query the database and re-compute to determine the next available highest speed printer connected to network 450. Since quality is not a preference of the user, a black-and-white image is assumed and since low-end laser printer 416 has a greater ppm capability than either the color ink jet printer 414 or the color laser printer 410, which are both capable of black-and-white but at lower speed, the server 460 will select low-end laser printer 416 as its next choice of appropriate printer. If low-end laser printer 416 is available and not busy, the print job will be spooled to low-end laser printer 416.” Again, this reference describes the database-related method of Yacoub and reveals nothing related to successful print task monitoring or analysis.

Although the examiner does not rely on Shah to disclose these elements, applicant must point out that Shah does not disclose these elements either. Accordingly, this rejection is improper and applicant requests reevaluation of the rejection.

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Based on the foregoing remarks, the Applicant respectfully requests reconsideration and allowance of the present application.

Respectfully submitted,



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